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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/158,728	09/22/1998	STEVEN CRAIG WEIRATHER	2419-US-B1	4296

63543 7590 12/28/2010

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EXAMINER	
CHEVALIER, ALICIA ANN	
ART UNIT	PAPER NUMBER
1783	

NOTIFICATION DATE	DELIVERY MODE
12/28/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	09/158,728	WEIRATHER ET AL.	
	Examiner	Art Unit	
	ALICIA CHEVALIER	1783	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 October 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *548-567,569-584,586,588,590-627,629-662,664,666-695 and 697-729* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *548-567,569-584,586,588,590-627,629-662,664,666-695 and 697-729* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/11/10*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

RESPONSE TO AMENDMENT

1. Claims 548-567, 569-584, 586, 588, 590-627, 629-662, 664, 666-695 and 697-729 are pending in the application, claims 1-547, 568, 585, 587, 587, 589, 628, 663, 665, 696 and 730-739 have been cancelled.

WITHDRAWN REJECTIONS

2. The 35 U.S.C. §103 rejections made of record in the office action mailed April 15, 2010, pages 2-12, paragraphs #3-#6 has been withdrawn due to Applicant's arguments in the response filed October 11, 2010.

REJECTIONS

3. **The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action**.

Claim Rejections - 35 USC § 103

4. Claim 548-567, 569-571, 574-578, 580-584, 586, 588, 590-611, 614-618, 620-627, 629-649, 652-656, 658-662, 664, 666-680, 683, 684, 686-695, 697-714, 717-720 and 722-129 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eagon (U.S. Patent No. 4,398,985) in view of Popat et al. (U.S. Patent No. 5,407,718) and Freedman (U.S. Patent No. 4,837,088).

Regarding Applicant's claims 548, 549, 582, 590, 591, 608, 627, 629, 631, 660, 661, 664, 677, 688-691, 693-695, 711, 719, 724-727 and 729, Eagon discloses a printable business card

sheet (abstract and col. 4, lines 50-53) which comprises a laminate sheet construction including a facestock sheet construction (ref. #101) and a continuous sheet (ref. #201) attached to a back side of the facestock sheet construction (figures 1b and 1c). The facestock sheet construction includes a facestock sheet (col. 3, lines 1-3). The laminate sheet construction includes an internally positioned film layer (ref. #12, col. 2, lines 7-8). The facestock sheet is a cardstock sheet (col. 3, lines 1-3). The top surface of the facestock sheet construction being constructed and adapted to receive indicia printed on the top surface during the printing operation (col. 4, lines 50-53). The continuous sheet is directly adjacent to the back side of the film layer and forms a delamination interface (figures 1b-1d and col. 3, lines 11-15). The laminate sheet construction is free of adhesive between the film layer (ref. #12) and the continuous sheet (ref. #201). The laminate sheet construction is a dry laminate sheet construction (col. 3, lines 11-15 and figure 1d). The film layer is between the facestock sheet and the continuous sheet (figure 1d).

Eagon discloses that the face stock may be preprinted (col. 4, lines 50-53), in other words Eagon envisions an embodiment where the face stock is not preprinted and therefore the entire front faces of the printable business card is blank. Furthermore, the court found that matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. MPEP 2144.4 I. Furthermore, where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, the content of the printed matter will not distinguish the claimed product from the prior art. MPEP 2112.01 III.

Eagon fails to disclose facestock continuous through-cut lines through the facestock sheet construction but not through-cut through the continuous sheet; the through-cut lines defining at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards; areas of the continuous sheet being positioned over back sides of all of the through-cut lines and thereby the continuous sheet is structurally capable of holding the printable business cards and the matrix waste portion together during the printing operation; the printable business cards being arranged in a grid, the grid including a column of printable business cards, and adjacent ones of the printable business cards in the column directly abut one another and share a common edge

Popat teaches label sheets used for printing with personal computers (col. 1, lines 12-19). The label sheets comprise a sheet construction that comprises a label layer, i.e. facestock sheet construction, and an adhesive layer, and backing layer (col. 2, lines 64-68), which acts as a release liner (col. 3, lines 18-19), i.e. carrier sheet. Popat's label comprises facestock continuous through-cut lines (die cut lines, col. 3, line 15) that pass through the facestock sheet construction to the back side but not through-cut through the carrier sheet (col. 3, lines 15-21) and that the through-cut lines are deemed to define at least in part perimeter edges of printable business cards and a matrix waste portion around the printable business cards (figure 1). Areas of the carrier sheet are positioned over the back sides of all the through-cut lines and thereby the carrier sheet is constructed and adapted to hold the printable business cards and the matrix waste portion together during the printing operation (figure 2 and col. 3, lines 15-21). The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet and from the matrix waste portion after the printing

operation into individual printed business cards (figure 1 and col. 3, lines 15-21). The die cuts also help facilitate ease of feeding into complex printer paths, such as those found on laser printers (col. 3, lines 1-4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add the die cut arrangement of the through-cut lines with the cuts only going through the facestock construction and not the carrier sheet of Popat to the sheet of Eagon in order to provide multiple labels/cards on one sheet and to help facilitate ease of feeding into complex printer paths, such as those found on laser printers (Popat col. 3, lines 1-4). Furthermore, it would have been an obvious matter of design choice to change the configuration of the through-cut lines, since a modification would have involved a mere change in size of the label. A change in size or shape is generally recognized as being within the level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). It is desirable to use Popat's through-cut lines configuration in order to maximize the number of labels per sheet.

Eagon fails to disclose that the film layer is adhered to the facestock sheet with an adhesive layer.

Freedman discloses a printable business card sheet comprising a dry laminate sheet construction including a facestock sheet construction and a continuous carrier sheet attached to a back side of the facestock sheet construction). The facestock sheet construction may also includes through-cut lines. The dry laminate sheet construction is deemed to be sized, constructed and adapted to be sheet-fed through a printer or copier for a printing operation on the printable business cards, since the reference discloses that the label stock may then be used for computerized printing on dry label or cards by the printer of a PC computer. The top surface of

the facestock sheet construction is deemed to be constructed and adapted to receive indicia printed on the top surface during the printing operation. The carrier sheet and the through-cut lines are deemed to be constructed and adapted to allow the business cards to be removed and separated from the carrier sheet after the printing operation into individual printed business cards whose back side surfaces are non-tacky, since the reference discloses that the labels will be picked-off individually by the user and that the dry labels of the invention have no tack when individually handled (figure 2). Freedman further discloses that the film layer is adhered to the facestock sheet with an adhesive layer (figure 2).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add an adhesive layer between the film layer and the facestock sheet of Eagon as taught by Freedman in order to ensure the film layer 12 stays adhered to the facestock layer 10 and not continuous sheet 201 (Eagon, col. 3, lines 15-18).

The combination of Eagon, Popat and Freedman disclose the laminate sheet construction is sized, constructed and capable of being sheet-fed through a printer or copier for a sheet-fed printing operation on the printable business cards (Popat col. 3, lines 1-4). The combination of Eagon, Popat and Freedman further disclose the continuous sheet and the through-cut lines is constructed and adapted to allow the business cards to be removed and separated from the continuous sheet and from the matrix waste portion after the printing operation into individual printed business cards whose back side surfaces are non-tacky (Eagon, col. 1, lines 9-12). The combination of Eagon, Popat and Freedman also disclose the film layer and the adhesive layer is adapted such that when a peeling force is applied to the printable business card sheet, the printable business card sheet delaminates at an interface of the film layer and the continuous

sheet and whereby the laminate sheet construction is a dry laminate sheet construction (Eagon, col. 2, lines 11-15 and figure 1d).

The preamble/limitation "business card" is deemed to be a statement with regard to the intended use and is not further limiting in so far as the structure of the product is concerned. In article claims, a claimed intended use must result in a **structural difference** between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. MPEP § 2111.02. Applicant has defined that "business card" as the cut out portion or separable portion of the sheet construction (specification page 1, lines 3-7 and page 3, line 25 through page 4, line 9).

Regarding claims 550, 551, 553-557, 559-564, 566, 567, 571, 574-578, 580, 581, 586, 593-597, 599-604, 606, 607, 611, 614-616, 618, 621, 626, 632-636, 638-643, 645, 646, 649, 652-654, 656, 659, 662, 667-670, 672-674, 676, 680, 684, 687, 692, 698-702, 704-709, 714, 717, 718, 720, 723 and 728, Popat further discloses all structural features the limitations of the claims, see figures 1 and 2.

Regarding Applicant's claims 552, 592, 630, 666 and 697, Eagon fails to disclose that the dry laminate sheet construction is 8.5 by 11 inches, 8.5 by 14 inches or has A4 width and length dimensions. However, Popat discloses that the label sheet may be a standard 8.5 by 11 inch sheet or other dimensions such as sheets with smaller dimensions, legal size or various other sizes which allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (col. 5, lines 1-11). Therefore, it would have been an obvious matter of design choice to change the size of sheet construction, since a modification would have involved a mere change in size. A change in size or shape is generally recognized as being within the

level of ordinary skill in the art, absent unexpected results. MPEP 2144.04 (I) and (IV). One of ordinary skill in the art would have been motivated to change the size of the sheet construction in Eagon in order to allow for printing the labels in a variety of different printers, including laser, ink jet and xerographic printers (Popat col. 5, lines 1-11).

Regarding Applicant's claims 552, 598, 637, 671 and 703, Eagon discloses that the film layer is a polyethylene layer (col. 3, lines 21-22).

Regarding Applicant's claims 565, 605, 644, 675 and 710, Eagon discloses that the continuous sheet includes a paper sheet (col. 4, lines 17-22).

Regarding Applicant's claims 569, 609, 647, 678, 712, Eagon fails to disclose that the adhesive layer is a hot melt adhesive layer, the film layer is a low density polyethylene film, and the continuous sheet is a densified bleached kraft liner sheet. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use these common material, since the selection of a known material based on its suitability for its intended use is prima facie obvious. MPEP 2144.07.

Regarding Applicant's claims 570, 610, 648, 679 and 713, Eagon fails to disclose that the film layer is approximately .8 mil thick. However, where in the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges in thickness involve only routine skill in the art, absence a showing of criticality. MPEP 2144.05 II.

Regarding Applicant's claims 583, 584, 622 and 624, Eagon discloses that the film layer is between the facestock sheet and the continuous sheet and the facestock sheet construction includes the film layer (figure 1d).

Regarding Applicant's claims 588, Eagon discloses that the continuous sheet is bonded to the film without adhesive (col. 3, lines 10-15 and figures 1a and 1b).

Regarding Applicant's claims 617, 623, 625, 655 and 683, Eagon discloses that the continuous sheet is secured directly to a back side of the film layer and the back side of the continuous sheet defines a back surface of the printable business card sheet (figures 1a and 1b).

Regarding Applicant's claims 620, 658, 686 and 722, Eagon discloses that wherein the continuous sheet carries the facestock sheet construction and thereby defines a carrier sheet and/or wherein the continuous sheet comprises a continuous liner sheet (figures 1a and 1b).

5. Claims 572, 573, 612, 613, 650, 651, 681, 682, 715 and 716 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eagon (U.S. Patent No. 4,398,985) in view of Popat et al. (U.S. Patent No. 5,407,718) and Freedman (U.S. Patent No. 4,837,088) as applied above, and further in view of Hickenbotham et al. (U.S. Patent No. 4,704,317).

Eagon, Popat and Freedman are relied upon as described above.

Eagon, Popat and Freedman fail to disclose an infeed edge of the printable business card sheet, along an entire width of the sheet is thinner than a body of the sheet or a lead-in edge of the printable business card sheet is calendered.

Examiner's comment: The limitation "the lead-in edge of the printable business card sheet is calendared" is a process limitation. However, this process limitation does add structure to the end product by crushing, compressing, making the calendared end thinner. So, for purposes of examination, any process that results in a crushed, compressed or thinner end is taken to anticipate the limitation "the lead-in edge of the printable business card sheet is

calendared," since the method of forming the product is not germane to the issue of patentability of the product itself.

Hickenbotham discloses crushing the corner of lablestock for use in printers or copier to provide a diagonal path of relatively low stiffness (col. 6, lines 9-16). The low stiffness in the front edge of the sheet allows the sheet to be dispensed through the printer or copier with greater easier (col. 1, lines 38-51).

It would have been obvious to one of ordinary skill in the art at the time of the invention to crush the edge of the sheet suggested by the combination of Eagon, Popat and Freedman above, as taught by Hickenbotham, in order to make the edge thinner than the rest of the sheet and to facilitate dispensing. One of ordinary skill in the art would have been motivated to crush the edge of the sheet because crushing the edge would provide a path of relatively low stiffness and would make the sheet easier to be dispensed through a printer as taught by Hickenbotham at col. 1, lines 38-51. It is desirable to have the sheet be easily dispensed through a printer so that the sheet does not get jammed in the printer.

6. Claims 579, 619, 657, 685 and 721 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eagon (U.S. Patent No. 4,398,985) in view of Popat et al. (U.S. Patent No. 5,407,718) and Freedman (U.S. Patent No. 4,837,088) as applied above, and further in view of Carlson (U.S. Patent No. 5,842,722).

Eagon, Popat and Freedman are relied upon as described above.

Eagon, Popat and Freedman fail to disclose that the facestock sheet construction comprises a top coating that forms a top receptive surface of each of the printable business cards.

Carlson discloses a printable laminate useful in forming die-cut identification cards, labels, etc. (col. 1, lines 16-18). The printable laminate includes die cut cards, which are coated with an ink receptive coating (col. 19, line 50 through col. 20, line 3). The ink receptive coating provides good ink image retention and adhesive retention (col. 20, lines 1-3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Carlson's ink receptive coating to the facestock sheet construction suggested by the combination of Eagon, Popat and Freedman in order to enhance the adhesion of the ink to the label. One of ordinary skill in the art would have been motivated to employ Carlson's ink receptive coating because of the improved image retention and adhesive retention of the ink (col. 20, lines 1-3). It is desirable to enhance the adhesion of the ink to the label so that the ink would not rub off after being applied to the label.

ANSWERS TO APPLICA*NT'S ARGUMENTS*

7. Applicant's arguments in the response filed October 11, 2010 regarding the previous rejections of record have been considered but are moot since the rejections have been withdrawn.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (571) 272-1490. The examiner can normally be reached on Monday through Thursday from 8:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alicia Chevalier/
Primary Examiner, Art Unit 1783
12/21/2010